UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
RUTTEN, JAMES D

ART UNIT	PAPER NUMBER
2192	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/922,616	BURKHARDT ET AL.
	Examiner	Art Unit
	J. Derek Rutten	2192

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 September 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,5,6,8-20,22 and 24-31* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,5,6,8-20,22 and 24-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 28 September 2005 has been entered. Claims 1,

5, 6, 10, 16, 17, 19, 22, 24, 25, and 29-31 have been amended, and claims 3, 4, 7, 13, 21, and 23

have been canceled. Claims 1, 2, 5, 6, 8-12, 14-20, 22, and 24-31 have been examined.

Response to Arguments

2.   Applicant's summary of arguments on page 12 paragraph 2 is gratefully acknowledged.

3.   In response to applicant's argument that the references fail to show certain features of

applicant's invention (page 10 paragraph 2), it is noted that the features upon which applicant

relies (i.e., "a customizable script to reduce conflicts and re-booting", and "execute the

OEMRUNONCE commands in a particular order") are not recited in the rejected claims.

Although the claims are interpreted in light of the specification, limitations from the specification

are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.

1993).

4.   In response to the argument that Harding does not recognize a staging order, review of

Harding reveals that a staging order is handled by way of special menu processing. While it

appears that modules are executed in the order they are downloaded, the order of downloading is

controlled by a menu. See column 11 lines 4-10. Thus, Harding recognizes the importance of a

staging order.

5.   In response to the argument that Harding fails to recognize that a staging order can be

controlled by a user customizable script, this argument is convincing. However, a new rejection

is made in view of U.S. Patent 6,189,051 to Oh et al.

6.   In response to applicant's argument that there is no suggestion to combine the references

(page 11 paragraph 1), the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention where

there is some teaching, suggestion, or motivation to do so found either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re*

Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21

USPQ2d 1941 (Fed. Cir. 1992). In this case, Brown is related to the installation of software

using a customizable file. Such teaching of the application of "INI" files clearly provides

motivation to automate an installation process in order to make deployment more efficient

(Brown paragraph 1). It is noted that the Applicant has suggested a passage from *In re Oetiker*,

977 F.2d at 1447; 24 U.S.P.Q.2nd at 1446 ("There must be some reason, suggestion, or

motivation found in the prior art whereby a person of ordinary skill in the field of the invention

would make the combination. That knowledge can not come from the applicant's invention

itself."). Motivation comes not from applicant's invention, but from Brown, as cited above.

7.   In response to applicant's argument that the examiner's conclusion of obviousness is

based upon improper hindsight reasoning, it must be recognized that any judgment on

obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

long as it takes into account only knowledge which was within the level of ordinary skill at the

time the claimed invention was made, and does not include knowledge gleaned only from the

applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392,

170 USPQ 209 (CCPA 1971).

8.   In response to the argument that Harding teaches away from the invention by executing

modules in the order that they are downloaded, it is noted that Applicant has not clearly

described which aspect of the invention Harding is teaching away from. It is agreed that Harding

does not expressly disclose a customizable script that defines staging order. However, further

consideration of Harding reveals disclose of customizable scripts (column 4 line 64 – column 5

line 2) and staging order (column 11 lines 4-10) separately. While Harding does not expressly

disclose the combination of these two elements, there does not appear to be any expressed

teaching away from it. Thus Applicant's argument is not convincing.

9.   Further arguments on pages 12-14 appear to be similar and based upon those addressed

above.

Drawings

10.   The drawings are objected to under 37 CFR 1.83(a). The drawings must show every

feature of the invention specified in the claims. Therefore, the "performing functions on the

reference system computer according to an order in which the programs are to be staged" (claims

1 and 19) must be shown or the feature canceled from the claims. No new matter should be

entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to

the Office action to avoid abandonment of the application. Any amended replacement drawing

sheet should include all of the figures appearing on the immediate prior version of the sheet,

even if only one figure is being amended. The figure or figure number of an amended drawing

should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure

must be removed from the replacement sheet, and where necessary, the remaining figures must

be renumbered and appropriate changes made to the brief description of the several views of the

drawings for consistency. Additional replacement sheets may be necessary to show the

renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet"

pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The

objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

11.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

12.   Claims 16, 17, and 29-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one skilled in the

relevant art that the inventor(s), at the time the application was filed, had possession of the

claimed invention. Claim 16 contains the limitation "a first configuration script of the customizable script" in lines 4 and 5. The originally filed specification describes a configuration script (e.g. page 4 lines 9-12, and page 11 line 17 – page 12 line 2). The specification describes the configuration script as being customizable, and in that respect, the configuration script appears to be the customizable script itself. No support could be found to describe any "configuration script of the customizable script". This limitation will be interpreted according to the original limitation which does not include the "customizable script", but only the "first configuration script". Claims 17, 29, and 30 includes similar limitations, and are rejected for the same reasons as claim 16.

13.   Claim 31 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 31 recites "a customizable configuration script...for defining an order in which the programs are to be staged" in lines 6-8. The originally filed specification describes configuration scripts that define an order in which programs are to be staged on a reference system computer (e.g. page 11 lines 17-21). The specification also describes the use of a configuration script to attach staged programs on a destination computer (e.g. page 14 lines 5-8). The configuration script as used on the destination system appears to be uniquely generated for each destination system (page 14 lines 5-6). However, the specification does not describe a configuration script as used on the destination computer that also defines an order in which programs are to be staged. The process of staging programs occurs on a reference system (page 11 lines 16-21), but

does not appear to occur on the destination system using the same configuration script. The

specification does not appear to describe a single configuration script that defines an order in

which programs are to be staged while performing functions on a destination computer. This

claim will be considered without this newly amended limitation.

Claim Rejections - 35 USC § 103

14.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

15.   Claims 1, 2, 5, 6, 10, 11, 14, 15, 18-20, 22, 25, 28, and 31 are rejected under 35 U.S.C.

103(a) as being unpatentable over prior art of record U.S. Patent 5,794,052 to Harding

(hereinafter "Harding") in view of U.S. Patent 6,189,051 to Oh et al. (hereinafter "Oh").

As per claim 1, Harding discloses:

A computerized method of installing programs on a destination computer (column

113 lines 2-40), *said method comprising:*

defining a customizable script defining a reference system comprising a computer

that has an operating system installed thereon and the programs previously staged

thereon wherein the customizable script includes performing functions ...according to an

order in which the programs are to be staged, See column 4 line 64 – column 5 line 2;

also column 11 lines 1-10:

> Any changes that are made to any of the files or directories resulting from the installing
> of that single particular module are recorded into a separate file associated with that
> module called a "script" file. Each module has an associated script file which specifies
> every change made to every file.
> ...
> FIX$FILE.BAT executes each module's batch program which runs each modules's script
> file located in the TEMP directory in the order that the modules are downloaded onto the
> hard disk drive 310. There are certain situations in which the operation of a certain
> software program depends upon whether that program is downloaded before or after
> certain other programs. Therefore, the computer manufacturer structures the menu
> selection system such that the download order of the selected modules will not create
> operational problems based upon load order.

Harding does not expressly disclose a script that performs *function on the*

reference system computer according to an order in which the programs are to be staged,

said order being defined by the customizable script. However, in an analogous

environment, Oh teaches that a setup file is used to perform functions on a reference

system according to a specified order. See column 4 lines 52-55:

> The setup file generating portion 530 generates information on the list of programs
> selected by the user interfacing portion 520 and the order in which the programs and
> drivers are installed as a setup file which can be executed.

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to use Oh's teaching of ordered setup files with Harding's script files. One of

ordinary skill would have been motivated to produce a master reference system in order

to reduce the probability of generating errors (Oh column 2 lines 2-9).

staging programs on a storage medium of the destination computer for later

installation on the destination computer, said staging the programs comprising copying

an image of the reference system to the storage medium of the destination computer and

storing installation files for the programs on the destination computer See column 10

lines 36-40:

> Typically, software program modules are downloaded from the mass data storage device 200 to the hard disk drive 310 via a parallel port connection, or a network connection between the mass data storage device 200 and the computer system 300.

also see column 13 lines 1-5:

> As shown in box 530, **when the end user first assembles and powers on the computer system,** the computer system boots up using the subset version of DOS that is installed at the factory. **This subset version runs the software setup program.**

Harding's background teaches that reference images containing an operating system of a reference system can be copied to a destination computer (column 1 line 61 – column 2 line 6).

selecting at least one of the staged programs for installation on the destination computer See column 13 lines 8-10:

> The software setup program also prompts the end user to select a language keyboard configuration.

attaching the selected program to complete the installation thereof on the destination computer See column 13 lines 29-31:

> At this point, the software setup program simulates the method of software installation used by the computer manufacturer when preparing computer systems for the U.S.

As per claim 2, the above rejection of claim 1 is incorporated. Harding further discloses: *detaching any of the programs not selected for installation on the destination computer* (column 5 lines 11-16. Unused modules are detached when selected modules are copied to the destination.).

As per claim 5, the above rejection of claim 1 is incorporated. Harding discloses a text-based configuration file (column 5 line 36. BAT files are known to be text-based.)

As per claim 6, the above rejection of claim 1 is incorporated. Further, Harding

discloses a script file that contains identification of file locations (column 4 line 64 –

column 5 line 1).

As per claim 10, the above rejection of claim 1 is incorporated. Harding further

discloses: *wherein attaching the selected programs includes performing one or more*

functions on the destination computer according to a customizable script (column 5 lines

30-45).

As per claim 11, the above rejection of claim 10 is incorporated. Harding further

discloses: *wherein the script is a text-based configuration file* (column 5 lines 35-38

describe use of a BAT file which is well known to be text-based.).

As per claim 14, the above rejection of claim 10 is incorporated. Harding further

discloses: *wherein attaching the selected programs includes executing an installation*

command routine according to the script (column 5 lines 35-37).

As per claim 15, the above rejection of claim 1 is incorporated. Harding further

discloses: *wherein the programs include either application programs, utility programs,*

or both (column 5 lines 3-16).

As per claim 18, the above rejection of claim 1 is incorporated. Harding further discloses: *A computer readable medium having computer-executable instructions* (column 5 lines 17-20).

As per claim 19, Harding discloses: *A system for configuring a computer* (FIG. 2). All further limitations have been addressed in the above rejection of claim 1.

As per claim 20, the above rejection of claim 19 is incorporated. All further limitations have been addressed in the above rejection of claim 2.

As per claim 22, the above rejection of claim 19 is incorporated. All further limitations have been addressed in the above rejection of claim 11.

As per claim 25, the above rejection of claim 19 is incorporated. All further limitations have been addressed in the above rejection of claim 14.

As per claim 28, the above rejection of claim 19 is incorporated. All further limitations have been addressed in the above rejection of claim 15.

As per claim 31, Harding discloses:

A computer-readable medium having stored thereon a data structure (column 5 lines 17-25) *comprising:*

a first data field including data identifying a plurality of staged programs See

column 5 lines 38-42:

> Once all of the module files, including its associated script file, are exploded and
> downloaded onto the hard disk drive, the FIX$FILE.BAT program runs the batch files
> associated with each installed module in the order that the modules are downloaded.

said programs being staged on the computer-readable medium for later

installation on a destination computer associated with the computer-readable

medium See column 10 lines 36-40:

> Typically, software program modules are downloaded from the mass data storage device
> 200 to the hard disk drive 310 via a parallel port connection, or a network connection
> between the mass data storage device 200 and the computer system 300.

a second data field including a configuration script for directing the destination

computer in performing functions See column 5 lines 45-50:

> The SCRIPT.EXE and associated module script files are programmed such that the
> execution of each module's script file by the SCRIPT.EXE program implements the
> changes required by that particular module to the appropriate configuration files and
> directories, in order to make that module work properly.

said functions including identifying at least one of the staged programs for

installation on the destination computer based on the data identifying the plurality of

staged programs See column 5 lines 30-45:

> The way in which the script files automatically implement changes to the configuration
> files is as follows. In a preferred embodiment, a software installation program, called a
> Hard Disk Master (HDM) program, is loaded onto the hard disk drive along with all of
> the modules necessary to fulfill a specifically requested configuration. The software
> installation program runs a batch program called FIX$FILE.BAT and an execution
> program called SCRIPT.EXE. Once all of the module files, including its associated script
> file, are exploded and downloaded onto the hard disk drive, the FIX$FILE.BAT program
> runs the batch files associated with each installed module in the order that the modules
> are downloaded. The module batch files include an instruction to run the SCRIPT.EXE
> program. The SCRIPT.EXE program executes the script file associated with that module.

16.   Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harding

and Oh as applied to claims 10 and 19 above, and further in view of prior art of record

"Microsoft Windows 2000 Server Unleashed" by Brown et al. (hereinafter "Brown").

        As per claim 12, the above rejection of claim 10 is incorporated. Harding further

discloses: *wherein the script identifies which of the staged programs are to be attached*

(column 10 lines 64-67). Harding does not expressly disclose a script that identifies

which of the staged programs are to be detached. However, Brown discloses a script

with predetermined answers to installation questions (Chapter 3: "answer file"). It would

have been obvious to one of ordinary skill in the art at the time the invention was made to

use Brown's predetermined answers in Harding's script. One of ordinary skill would

have been motivated to provide an unambiguous list of software that is available and that

should or should not be installed.

        As per claim 24, the above rejection of claim 19 is incorporated. All further

limitations have been addressed in the above rejection of claim 12.

17.   Claims 8, 9, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Harding and Oh as applied to claims 1 and 19 above, and further in view of prior art of record

"Windows 95 Installation and Configuration Handbook" by Tidrow et al. (hereinafter "Tidrow").

As per claim 8, the above rejection of claim 1 is incorporated. Harding further discloses: *wherein staging the programs includes copying files associated with the programs to the storage medium of the destination computer without storing configuration data associated with the programs* (column 10 lines 47-54 and column 5 lines 45-50). Harding does not expressly disclose *wherein the destination computer has a registry for storing configuration data.* However, in an analogous environment, Tidrow teaches an operating system that has a registry for storing configuration data (page 407 "Using the Registry"). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Tidrow's teaching of a registry to store the configuration files of Harding. One of ordinary skill would have been motivated to consolidate the various configuration files into a single database for easier and more efficient storage and retrieval of configurations and settings.

As per claim 9, the above rejection of claim 8 is incorporated. Harding further discloses: *wherein attaching the selected programs includes storing configuration data associated with the selected programs* (column 5 lines 45-50). All further limitations have been addressed in the above rejection of claim 8.

As per claims 26 and 27, the above rejection of claim 19 is incorporated. All further limitations have been addressed in the above rejections of claims 8 and 9, respectively.

18.   Claims 16, 17, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Harding and Oh as applied to claim 1 above, and further in view of Brown in view of the

"Background of the Invention" section appearing in columns 1-4 of Harding (hereinafter

"Harding's background").

        As per claim 16, the above rejection of claim 1 is incorporated. Harding further

discloses: *executing a first installation utility on a reference computer* (column 4 lines

59-64); *controlling the first installation utility to stage the one or more programs on a*

storage medium of the reference computer (column 5 lines 17-25); Harding does not

expressly disclose: *controlling the first installation utility according to a first*

configuration script; installing an operating system on the reference computer using the

installation utility; defining a reference image of the storage medium of the reference

computer having the operating system installed thereon and the programs staged

thereon; and copying the reference image to the destination computer. However, in an

analogous environment, Brown teaches controlling an installation utility according to a

configuration script (Chapter 3: "UNATTEND.TXT"), and installing an operating system

using an installation utility (Chapter 3: "Automated Installation"). Also, Harding's

background teaches that reference images containing an operating system of a reference

system can be copied to a destination computer (column 1 line 61 – column 2 line 6). It

would have been obvious to one of ordinary skill in the art at the time the invention was

made to use Brown's installation utility and configuration script along with Harding's

background teaching of reference images in Harding's system. One of ordinary skill

would have been motivated to maintain a reference image that can be packaged and distributed to computers that may not have direct access to a reference computer. A reference image allows a custom distribution of software modules to be selected and installed on a destination computer.

As per claim 17, the above rejection of claim 16 is incorporated. Harding further discloses: *executing a second installation utility on the destination computer; and controlling the second installation utility according to a second configuration script to attach the selected program on the destination computer* (column 5 lines 35-45).

As per claims 29 and 30, the above rejection of claim 19 is incorporated. All further limitations have been addressed in the above rejections of claims 16 and 17, respectively.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Derek Rutten whose telephone number is (571) 272-3703. The examiner can normally be reached on T-F 6:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jdr

TUAN DAM
SUPERVISORY PATENT EXAMINER